

## REMARKS

Applicant has amended claims 1, 12 and 13 to clarify the invention and to place the application in a condition for allowance. The text of the rewritten claims marked-up to show the changes relative to the previous version of the claims is attached herewith in Appendix A in accordance with 37 C.F.R. § 1.121(c)(1). In addition, Applicant has added new claims 14-17 to further require a magnet in the bottom portion of the improved holder. No new matter is added. Accordingly, reconsideration is respectfully requested.

The Examiner has rejected claim 13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because no proper antecedent is found in line 2 for “said first surface”. As amended, claim 13 has been clarified to replace “said first surface” with “said outer surface.” Accordingly, reconsideration is respectfully requested.

The Examiner has also rejected claims 1, 3, 6, 9, 10 and 12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,791,608 to Nielsen *et al.* (“Nielsen”) on grounds that Nielsen shows a “holder comprising a wrap having hook and loop fasteners (18a, 18b) and a magnetic means (22) self cover to prevent damages to metal finishes.” Applicant respectfully traverses the rejection because Nielsen does not show an elongated holder for partially encompassing a device while leaving a functional portion of the device (i.e., a drinking portion) exposed for use. Anticipation requires an identity of inventions which is not the case with Nielsen and the claimed invention.

Each aspect of the claimed holder must be described or embodied in the Nielsen reference, and all such claimed subject matter must be disclosed therein with sufficient specificity, for Nielsen to serve as a proper anticipatory reference. See Glaverbel Societe

Anonyme v. Northlake Marketing & Supply Inc., 33 U.S.P.Q.2d 1496 (Fed. Cir. Jan. 23, 1995).

The Nielsen reference discloses a storage retainer for a paint brush and requires multiple folding panels that resemble a cross-shape. The panels fold over and fasten on one another. The panels are designed to cover and completely enclose the functional portion of the brush, i.e., the bristles. The Nielsen retainer serves to protect the brush, as a “keeper,” and is specifically provided as an alternative to traditional paper covers. *See* Column 1, lines 37-38. Regardless that Nielsen contains folding panels with hook and loop fasteners and a magnetic means, it does not show every aspect of the claimed holder.

The claimed holder is designed to accommodate a liquid-containing device that has a functional portion. The holder comprises of an essentially elongated element having two ends, a first surface, a second enjoining surface, at least one attachment means at opposite ends on each of the surfaces, and a magnetic means that is positioned on a portion of the first surface. The elongated element encircles a device to provide an exposable functional portion. The Nielsen reference cannot anticipate the claimed holder because it only shows a cross-shape of multiple panels for fully retaining and completely enclosing a brush. It simply does not embody an elongated element that fits about a liquid-containing device so that a portion of the device remains open and fully functional. Accordingly, because it fails to show each and every aspect of the claimed holder, the Nielsen reference cannot form a proper basis on which to anticipate the claimed invention.

The Examiner has also rejected claims 2, 4, 7, 8, 11 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Nielsen on grounds that the “strength of the magnet used in the device, the material from which the same is being made of, its dimension and use of decoration all are seen as obvious matter of engineering choice having no patentable significance.” Applicant

respectfully traverses the rejection because one skilled in the art would not find the claimed cup holder obvious in light of the Nielsen brush retainer for at least the reasons set forth above.

Prior art is insufficient to form a basis for establishing unpatentability unless the art also contains some teaching, suggestion or incentive to look to particular sources of information, to select particular elements, and to combine them to arrive at the claimed invention. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931 (Fed. Cir. 1990). The Nielsen reference simply contains no suggestion to one skilled in the art that its dimensions could be redesigned to exclude the multiple flaps and employ an elongated element. Moreover, nowhere does Nielsen suggest that it could hold a liquid-containing device while leaving exposed the functional aspect of the device. Even if it were elongated or could hold such a device, Nielsen does not suggest that a magnet (let alone a very strong magnet) would offer any advantage to the combination. Instead the Examiner improperly reads “teaching” into the reference that simply does not exist to incorrectly conclude that the Nielsen brush retainer shows a holder for functional use.

In fact, Nielsen specifically teaches away from an elongated element that allows for an exposable functional portion of a device. To the contrary, the specific teachings of the Nielsen reference state that the brush retainer is designed to have multiple flaps to protect and keep brushes, requiring that the bristles be completely enclosed within the flaps. No correlation can be deduced between the enclosed, unusable brush and the claimed elongated device with exposed functional portion. Such teaching away is the antitheses of the suggestion that one of ordinary skill in the art go in the direction of the claimed invention. Teaching away from the art is a *per se* demonstration of lack of *prima facie* obviousness. In re Dow Chemical Co., 837 F.2d 469 (Fed. Cir. 1988). If Nielsen were simply an elongated element it could not function as a storage device for keeping brushes. Furthermore, it is contrary to this purpose to suggest leaving the

brush bristles exposed for use, as with the functional portion of the liquid-containing device held by the claimed invention.

Furthermore, Nielsen does not disclose a magnet of enhanced strength, nor does it show or disclose a magnet in a bottom portion of the retainer. In fact, the Nielsen retainer does not have a bottom portion, *per se*, because it is not designed to support the brush from the bottom, bristle edge, but rather to minimize pressure to the bristles. For at least all of the foregoing reasons the Nielsen reference does not teach or suggest to one skilled in the art the claimed holder device. Accordingly, the Nielsen reference cannot form a proper basis on which to obviate the claimed holder device.

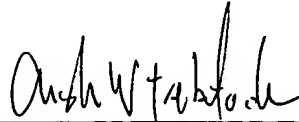
With regard to the Examiner's rejection of the dependent claims 3-13, the Examiner has generally dismissed the limitations without providing any specific evidence that the additional limitations in these claims are disclosed in or suggested or taught by prior art. A rejection based on section 102 or 103 must rest on a factual basis, which means the Examiner has a duty to specify the prior art relied on and to describe where in the prior art there is a teaching or suggestion of the claimed features. It is improper for the Examiner to resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *See In re Warner*, 379 F.2d 1011 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The Examiner's rejection of dependent claims 3-13 is without necessary supportive evidence, thus the Examiner has not met the burden of establishing a *prima facie* case of anticipation or obviousness with respect to these claims.

Applicant respectfully submits that the patent application and the claims, as amended, therein are in a condition for allowance. Accordingly, reconsideration and allowance of the claims are respectfully requested.

Applicant would appreciate the courtesy of a telephone call should the Examiner have any questions or comments with respect to this response or the claim language for purposes of efficiently resolving same.

Respectfully submitted,

By



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## APPENDIX A

Please find below claims 1, 12 and 13 marked-up to show the changes incorporated in the above amendment:

1. (amended) An improved holder for a liquid-containing device, said device <sup>11</sup> having a functionable portion, comprising an essentially elongated element having two ends, a first surface, a second enjoining surface, at least one attachment means <sup>21, 31</sup> on each of said surfaces at opposite ends of said surfaces, and a magnetic means <sup>50</sup> positioned on a portion of said first surface wherein said elongated element encircles said device while having exposable said functionable portion.

12. (amended) ~~An improved holder method~~ for removeably affix ~~holding a liquid-containing device and mounting it to a magnetic accepting surface comprising of encircling said device with a wrap element formed with two attachable overlapping ends capable of securely encircling said device, said wrap element having an outer surface with a magnetic means imbedded therein or attached thereto, thereby allowing and mounting said holder element in combination with said device to affix to said magnetic accepting surface.~~

13. (amended) ~~An improved holder method~~ as set forth in claim 12, said wrap element further including a decorative pattern on all or a part of said ~~first outer~~ surface.